

REMARKS

Claims 1-39 are pending in the present application.

Applicants incorporate herein their comments from the previous Amendment. The Board of Patent Appeals and Interferences issued its decision on September 25, 2006 (“Board Decision”). The Board Decision addressed the rejection of claim 32 by U.S. Patent No. 5,855,007 to Jovicic (“Jovicic”) and stated that “In Jovicic, there is no disclosure of the user being enabled to select a reward for redemption from the list of rewards previously collected by the user, because in Jovicic, the redemption performs this function, and there is no evidence in the record to suggest the obviousness of this limitation.” Board Decision, p. 17 (emphasis in original). The emphasized language was incorporated into the claims. Prosecution has been re-opened based on the Jovicic reference. Applicant contends that prosecution was improperly re-opened.

Claims 1, 5-13, 16-22, 24-25 and 38 were rejected under 35 U.S.C. § 102(e) as being anticipated by Jovicic or in the alternative under 35 U.S.C. § 103(a) as being unpatentable over Jovicic. Claims 2-4, 14-15, 23, 26-31 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jovicic. Claims 32-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Jovicic in view of U.S. Patent No. 6,237,145 to Narasimhan et al. (“Narasimhan”).

Each of the pending independent claims refers to the user being able to select a reward for redemption from the list of rewards previously collected by the user (see claim 32). Claim 1 refers to viewing “a list of rewards that have been allocated to the user and enabling the user to select a reward for redemption from the list of rewards.” Claim 17 recites, “when the user

wishes to redeem a reward, the central computer allowing the user to view a list of rewards associated with the user as stored in the database; allowing the user to select a reward from the list of rewards for redemption by interacting with the database.” Claims 19, 20 and 38 include similar limitations.

The current Office Action states that this feature is found at col. 6, lines 11-13 as enabling a user to view a list of rewards. The Board’s Decision was quite clear that Jovicic does not disclose the feature in the claims. Col. 6, lines 11-13 of Jovicic, read as follows “... a browsing memory 128 where representative coupon or coupons are stored and ready for selection by users.” There is nothing in this cited section or anywhere in Jovicic that states that coupons in the browsing memory are those “previously collected” by the user. The language of the cited section is that the coupons are “representative” and thus available to all users accessing the Internet Coupon Server 124 (see, e.g., Col. 6, lines 39-48).

After these representative coupons are stored in memory 128, the further citations from Jovicic (Col. 7, lines 24-40 and Col. 8, lines 48-49) refer to selecting a coupon and allocating it to a user. Applicant notes that Board Decision refers to the disclosure of Jovicic, generally, but also specifically cites:

Col. 2, lines 48-51 (“to provide a system which generates coupons with unique serial numbers and upon selection of such coupons by the consumer, records the selection, including coupon's serial number and user's identification number in the coupon database;”)

Col. 4, lines 41-45 (“The electronic coupon generation process includes taking

coupon indicia and digital representations of graphical images in the coupon data base, coupling the coupon indicia with the user indicia in the user data base, and placing the coupon indicia in a browsing memory to represent an electronic coupon.”)

Col. 8, lines 19-23 (“An added feature of the invention is that the user may choose to e-mail the coupon to him or herself allowing him or her to store the coupon for a later date handling or to send it directly to the vendor's Internet node over public computer network.”)

In affirming the rejection of claim 1, the Board Decision states “[f]rom this disclosure, we find that Jovicic, the reward (coupon provided as a result of the customer selecting the image from among all of the available images) is allocated to the user when the user selects an advertising image.” Board Decision, pg. 10. The Board has already considered this feature of Jovicic and in its decision states that the feature of “the user being enabled to select a reward for redemption from the list of rewards previously collected by the user” is not shown in Jovicic nor obvious in view of Jovicic. Board Decision, p. 17. The citations of Col. 7, lines 24-40 and Col. 8, lines 48-49 appear to be cumulative in view of the issues already considered by the Board.

The current Office Action states that “the examiner believes the Board erred in its implicit interpretation of ‘collected by the user’.” (p. 6). First, the Applicants presented their arguments as to the patentability of claim 32, and the Examiner submitted an Answer to rebut the Applicants arguments. Second, an oral hearing was conducted, and though the Examiner is not required to attend or to present arguments, the Examiner chose not to do so. Third, after the

Board issued its Decision, the Examiner was afforded an opportunity for rehearing (MPEP 1214.04), but did not request one. In view of this, the Board's Decision on the feature of claim 32 should be considered final, binding, and cannot be ignored. The Examiner is allowed to re-open prosecution (MPEP 1214.07), but only for matters not already adjudicated. As previously stated, Applicant contends that prosecution was improperly re-opened in this case.

The position taken by the Examiner effectively prevents meaningful review by the Board of Patent Appeals and Interferences.

Col. 6, lines 29-36 of Narashimhan add nothing to the cited sections of Jovicic. In view of the Board's Decision and its specific dealing with the Jovicic reference, the issue of whether the feature of claim 32 that has been added to each of the independent claims has been resolved in Applicants' favor. Accordingly, reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §§ 102(e) and/or 103(a) is respectfully requested.

CONCLUSION

The Applicants respectfully submit that the present case is in condition for allowance and respectfully requests that the Examiner issue a notice of allowance.

The Office is hereby authorized to charge any fees determined to be necessary under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayment to Kenyon & Kenyon **Deposit Account No. 11-0600**.

The Examiner is invited to contact the undersigned at (202) 220-4255 to discuss any matter concerning this application.

Respectfully submitted,

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